

REMARKS

Status of the Claims

Claims 1-15, 17, 18 and 20 are pending in this application. Claim 19 has been canceled. No claims have been added. Claim 1 has been amended to incorporate the subject matter of claim 19. No new matter has been added by the above claim amendments. No new issues have been raised that would require additional consideration or search. As such, Applicants respectfully request that the amendments are entered.

Rejection under 35 USC 112, second paragraph

The Examiner rejects claims 1-11 as indefinite. The Examiner suggests that the second reference to the separate photosensitive layer recite "said" instead of "a". Applicants amend claim 1 as suggested in order to clarify the invention. As such, the rejection should be withdrawn.

Rejection under 35 USC 103(a)

The Examiner rejects claims 1-3, 12, 13, 15, 17-20 as obvious over EP 0803764 (EP '764). Applicants traverse the rejection and respectfully request the withdrawal thereof.

The present invention is directed to heat developable image-recording material comprising on a support a silver-supplying layer

comprising an organic silver salt, a reducing agent, an organic binder and photosensitive silver halide in an amount that is 10 wt% or less of a coated amount of photosensitive silver halide in a separate photosensitive layer and said separate photosensitive layer comprising a photosensitive silver halide and no organic silver salt, and the heat developable image-recording material further containing an electron transfer agent.

EP '764 discloses a photothermographic material that contains a photosensitive layer containing silver halide, a binder, an organic silver salt, reducing agent, toner, antifoggant, matter agent, lubricant, crosslinking agent, surfactant, dyestuff and other suitable additives. There may also be two or more photosensitive layers in the material in EP '764.

Applicants submit that EP '764 fails to disclose or suggest that one of the photosensitive layers in the material may be free of organic silver salt as with the present invention. There is no suggestion that one of the "two or more photosensitive layers" disclosed at page 3, line 43 of EP '764 contains no organic silver salt. Applicants also submit that page 5, line 30 of EP '764 merely discloses that organic silver salt may be added to the photosensitive layer, meaning that if organic silver salt is added to the photosensitive layer, then organic silver salt will be added to all the photosensitive layers. There is no suggestion that if

one of ordinary skill in the art were to add organic silver salt to the photosensitive layers, that one of the layers should be free of organic silver salt.

Moreover, all the examples in EP '764 have organic silver salt in the photosensitive layer. There is only a protective layer (non photosensitive layer), which contains no organic silver salt. At best, EP '764 discloses a material that has one or more photosensitive layers, where if one layer contains organic silver salt, then all layers also contain organic silver salt.

Comparative Example A in Table 1 on page 87 of the specification of the present application corresponds to EP '764. See page 84, "Preparation of Comparative Sample A" continuing to page 85, where it is clear that Comparative Sample A has photosensitive layers with organic silver salt. Table 1 demonstrates the unexpected superior properties of the present invention as compared to Comparative Sample A. Furthermore, Applicants submit that one of ordinary skill in the art would not know to refrain from adding organic silver salt to one of the photosensitive layers while the other photosensitive layer(s) contain organic silver salt to achieve these superior properties of the present invention.

For the foregoing reasons, Applicants submit that no *prima facie* case of obviousness has established as all the elements of

the present invention are not disclosed or suggested by EP '764 and the rejection should be withdrawn.

The Examiner also rejects claims 4-11 and 14 as obvious over EP '764 further in view of Murray '324, Murray '515 and Toya '419. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants rely on the arguments above regarding EP '764 failing to disclose or suggest a heat-developable image recording material that has a separate photosensitive layer that contains no organic silver salt. Applicants also submit that neither Murray, '324, Murray '515 nor Toya '419 compensate for the deficiencies in EP '764. As such, this rejection should be withdrawn.

### Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$420.00 is attached hereto.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the

telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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